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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of   :   Customer Number: 46320
                                              :
Mark PETERS et al.   :   Confirmation Number: 6041
                                              :
Application No.: 10/675,503   :   Group Art Unit: 3609
                                              :
Filed: September 30, 2003   :   Examiner: B. Fields
                                              :

For: DYNAMIC PROCESSING OF PAYMENT REQUESTS FOR MOBILE COMMERCE
        TRANSACTIONS

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

       This Appeal Brief is submitted in support of the Notice of Appeal filed April 8, 2008,

wherein Appellants appeal from the Examiner's rejection of claims 1-12.

I. REAL PARTY IN INTEREST

       This application is assigned to IBM Corporation by assignment recorded on September

30, 2003, at Reel 014572, Frame 0992.

II. RELATED APPEALS AND INTERFERENCES

       Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-12 are pending and two-times rejected in this Application. It is from the multiple rejections of claims 1-12 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second and Final Office Action dated January 8, 2008 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1   Referring to Figure 2 and to independent claim 1, a mobile commerce system is

2   disclosed. The system includes a plurality of mobile server wallets 230, a proxy server 240, and

3   a filter plug-in 270. Each of the wallet 230 have an association with a corresponding subscriber

4   210 in a wireless service provider network (page 7, lines 13-17). The proxy server 240 is

5   disposed in the wireless service provider network (page 7, lines 21-22). The filter plug-in 270 is

6   coupled to the proxy server 240 and is configured to intercept selected payment messages 290

7   flowing through the proxy server 240 (page 8, lines 1-8) and to route the payment messages 290

8   to selected ones of the mobile server wallets 230 (page 8, lines 9-11).

9   Referring to Figure 3 and to independent claim 5, a method for processing mobile

10   commerce transactions in a wireless service provider network is disclosed. In blocks 320, 330,

11   messages flowing between merchants and subscribers to the wireless service provider network

12   are filtered to identify specific payment messages associated with specific subscribers in the

13   wireless service provider network (page 9, lines 4-8). In block 350, filtered ones of the payment

1   messages are routed to specified mobile server wallets associated with the specific subscribers

2   (page 9, lines 9-10).

3   Referring to Figure 3 and to independent claim 9, a machine readable storage having

4   stored thereon a computer program for processing mobile commerce transactions in a wireless

5   service provider network is disclosed. The computer program comprising a routine set of

6   instructions for causing the machine to perform the following steps. In blocks 320, 330,

7   messages flowing between merchants and subscribers to the wireless service provider network

8   are filtered to identify specific payment messages associated with specific subscribers in the

9   wireless service provider network (page 9, lines 4-8). In block 350, filtered ones of the payment

10   messages are routed to specified mobile server wallets associated with the specific subscribers

11   (page 9, lines 9-10).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-12 were rejected under 35 U.S.C. § 102 for anticipation based upon Suzuki et al., U.S. Patent Publication No. 2002/0032616 (hereinafter Suzuki).

VII. ARGUMENT

1   **THE REJECTION OF CLAIMS 1-12 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED**

2   **UPON SUZUKI**

3   For convenience of the Honorable Board in addressing the rejections, claims 3-12 stand

4   or fall together with independent claim 1; and claim 2 stands or falls alone.

5

6   As is evident from Appellants' previously-presented comments during prosecution of the

7   present Application and from Appellants' comments below, there are questions as to how the

8   limitations in the claims correspond to features in the applied prior art. In this regard, reference

9   is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the

10   following is stated:

11   (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
12   answer is <u>required to include</u>, under appropriate headings, in the order indicated, the following
13   items:
14   ...
15   (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions
16   as to how limitations in the claims correspond to features in the prior art even after the
17   examiner complies with the requirements of paragraphs (c) and (d) of this section, the
18   examiner <u>must</u> compare at least one of the rejected claims <u>feature by feature</u> with the
19   prior art relied on in the rejection. The comparison <u>must</u> align the language of the claim
20   side-by-side with a reference to the specific page, line number, drawing reference
21   number, and quotation from the prior art, as appropriate. (emphasis added)
22
23   Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's

24   Answer, the Examiner is required to include the aforementioned section in the Examiner's

25   Answer.

26

27   Prior to addressing the specifics of the Examiner's rejection, Appellants note that the

28   Examiner's rejections includes a number of irregularities. These irregularities include the stealth

29   citing of a secondary reference in an anticipation rejection, the failure to specifically identify the

1   teachings being relied upon in the rejection as required under with 37 C.F.R. § 1.104(c)[1],

2   misapplying case law, and (extensively) responding to arguments not made by Appellants.

3

4   The factual determination of anticipation under 35 U.S.C. § 102 requires the <u>identical</u>

5   disclosure, either explicitly or inherently, of <u>each</u> element of a claimed invention in a single

6   reference.[2] Moreover, the anticipating prior art reference must describe the recited invention

7   with sufficient clarity and detail to establish that the claimed limitations existed in the prior art

8   and that such existence would be recognized by one having ordinary skill in the art.[3] As part of

9   this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the

10   meaning of the elements in light of the specification and prosecution history, and (c) identify

11   corresponding elements disclosed in the allegedly anticipating reference.[4] This burden has not

12   been met.

13

14   <u>Claim 1</u>

15   On pages 8 and 9 of the Amendment filed November 20, 2007 (hereinafter the First

16   Amendment), Appellants presented the following arguments. Appellants note that the

17   Examiner's analysis relies on generalizations and **ignores** the <u>specific language of the claims</u>.

---

[1] 37 C.F.R. § 1.104(c) provides:

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

[2] <u>In re Rijckaert</u>, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); <u>Richardson v. Suzuki Motor Co.</u>, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); <u>Perkin-Elmer Corp. v. Computervision Corp.</u>, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

[3] <u>See</u> <u>In re Spada</u>, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); <u>Diversitech Corp. v. Century Steps, Inc.</u>, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

[4] <u>Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.</u>, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1   Appellants also note that the Examiner's cited passages of Figures 3-4 and 6-7 as well as

2   paragraphs [0020]-[0023] and [0030] describe what Appellants has already admitted is prior art

3   (i.e., see Fig. 1 of Appellants' specification).

4

5   For example, regarding the claimed "plurality of mobile server wallets each wallet having

6   an association with a corresponding subscriber in a wireless service provider network," the

7   Examiner cited Figures 3-5 and 6-7 while stating "Suzuki displays figure which depict a system

8   that is capable of facilitating the transactions between multiple mobile server wallet's."

9   <u>Completely absent</u> from the Examiner's analysis is any identification of a teaching within Suzuki

10   that "each wallet having an association with a corresponding subscriber," as claimed.

11

12   In responding to these arguments, the Examiner asserted the following in the paragraph

13   spanning pages 8 and 9 of the Second Office Action:

14   The Examiner respectfully disagrees. The Examiner has pointed to Figures 3-4 and 6-7 to
15   show Suzuki's disclosure of a Wallet Server in figures. As the instant application is primarily
16   directed towards wallet servers, the conventional use of a non-that subscriber may be a merchant
17   or customer) for quicker usability upon successive iterations within the system/method.
18
19   The Examiner's response is emblematic of the Examiner's failure to set forth a proper rejection

20   and to clearly identify the specific teachings within Suzuki being relied upon. Notably, the

21   Examiner does not address the specific language of the claims and the Examiner's only generally

22   cites to Figure 3-4 and 6-7. Based upon the Examiner's response, Appellants would conclude

23   that the Examiner has again failed to establish that Suzuki identically discloses the limitations at

24   issue.

25

1   However, upon reviewing a portion of Suzuki not cited by the Examiner, Appellants have

2   found the following teachings in paragraph [0052] of Suzuki:

3   The wallet server 60 is provided with personal wallets 61_1 and 62_2 which are well-known
4   electronic wallets installed for each of users and with a control section 62 used to control the
5   requests for the payment processing including requests for login processing to the wallet server 60
6   and for the settlement for each of the users to the settlement host 75.
7
8   Had the Examiner cited this paragraph in the First Office Action, the Examiner could have

9   narrowed the issues prior to appeal.[5] Notwithstanding the teachings of paragraph [0052] and the

10   Examiner's above-reproduced assertions, the Examiner has failed to factually establish that the

11   users to the settlement host 75 are "a corresponding subscriber in a wireless service provider

12   network," as claimed.

13

14

15   In the first full paragraph on page 9 of the First Amendment, Appellants presented the

16   following arguments. Regarding the claimed "filter plug-in coupled to said proxy server and

17   configured to intercept selected payment messages flowing through the proxy server and to route

18   said payment messages to selected ones of said mobile server wallets," the Examiner cited

19   paragraphs [0028]-[0029] and [0033]-[0038], while asserting "[u]pon system authentication

20   within the network, payment messages are routed back and forth via the system through the filter

21   plug-in coupled to the proxy server." Appellants have reviewed the Examiner's cited passage

22   and are entirely unclear as to where Suzuki specifically identically discloses the claimed proxy

23   server and the claimed filter plug-in.

24

---

[5] See M.P.E.P. § 706.07 ("Before final rejection is in order a clear issue should be developed between the examiner and applicant.")

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1   In responding to these arguments, the Examiner asserted the following on page 10 of the

2   Second Office Action:

3   The Examiner respectfully disagrees. The Examiner notes: Conventional Wallet Servers,
4   etc. comprise a single entity that operates between a merchant and a customer. This 'single-entity'
5   usually/essentially is found in the middle of the merchant and the consumer and is used by both.
6   The consumer communicates with the wallet, and the wallet, in turns, communicates with the
7   merchant through the merchant's website. In effect, this entity can be compared to as a filter of
8   sorts in order to achieve successful system interoperability as disclosed; henceforth a filter is
9   implicitly taught in Suzuki. It is commonly known to a person of ordinary skill in the art that a
10   filter is involved in an initiation of an electronic payment transaction, a communication terminal of
11   a customer, or a transaction server. A filter serves as a primary part of the communication system;
12   the communication system allows a communication between the server of the merchant, the
13   communication terminal and the transaction server. The filter, has, among others, the task of
14   forwarding certain messages concerning the electronic payment transaction to assigned receivers.
15   Filters can be a part of a communication system, such as a GSM, GPRS, PPDC, WCDMA,
16   UMTS, Bluetooth type networks, etc. by way of example. In addition, the filter allows among
17   others, that certain messages be redirected to the transaction server for the communication
18   terminal.
19
20   Notably absent from this passage is any citation to specific passages within Suzuki. As such, the

21   Examiner has failed to specifically identify, as required under 37 C.F.R. § 1.104(c), where these

22   teachings can be found within Suzuki.

23

24   The Examiner's assertions through the statement of "… communicates with the merchant

25   through the merchant's website" have already been recognized by Appellants as prior art (see

26   Fig. 1 and pages 2 and 3 of Appellants' disclosure). However, these statements do not lead to the

27   claimed limitations at issue.

28

29   The Examiner then asserts "[i]n effect, this entity can be compared to as a filter of sorts in

30   order to achieve successful system interoperability as disclosed; henceforth a filter is implicitly

31   taught in Suzuki." This statement by the Examiner is both conclusory and lacks factual support.

32   As claimed, the filter plug-in "intercept[s] payment messages flowing through the proxy server."

33   Then, as claimed, the filter plug-in "route[s] said payment messages to selected ones of said

1   mobile server wallets." If, as asserted by the Examiner, a wallet "can be compared to as a filter,"

2   then the issue not addressed by the Examiner is why would Appellants claim separate mobile

3   server wallets and a filter plug-in when the wallet could serve as a filter? The answer to this

4   question is that a wallet and a filter are not comparable features. A wallet is a store of

5   information about a consumer that can be used by a retailer, whereas a filter, based upon a

6   selection criteria, routes certain messages. Thus, the Examiner's assertion is poorly founded.

7

8   The Examiner's next statements (i.e., from "[i]t is commonly known ..." through "....

9   "for the communication terminal"), which are the remainder of the paragraph, are respectively

10   found in paragraphs [0015] and [0044] of Schuba et al., U.S. Patent Publication No.

11   2002/0052842 (hereinafter Schuba), which the Examiner made of record in the First Office

12   Action. Why the Examiner referred to these teachings from Schuba without either citing Schuba

13   itself or setting forth a new rejection based upon Schuba is unclear to Appellants.

14   Notwithstanding this unusual (stealth) citation to a secondary reference, these teachings from

15   Schuba do not establish that Suzuki explicitly or inherently identically disclose all of the claimed

16   limitations.

17

18   Moreover, under the assumption that the Examiner intended to reject the claims under 35

19   U.S.C. § 103 for obviousness based upon Suzuki in view of Schuba, the Examiner did not (i)

20   establish a realistic common sense rationale for making the modification and (ii) properly

21   characterize the teachings of the applied prior art. For example, as already noted above, Suzuki

22   does not teach a filter. With regard to Schuba, the teaching of a filter (FI) is used in conjunction

23   with transaction servers (WS), which are not comparable to the claimed mobile server wallets.

1   Instead, the transactions servers (WS) appear to be associated with different credit cards (see

2   paragraph [0049] of Schuba). Thus, Appellants' position is that the claimed invention would not

3   have been obvious to one having ordinary skill in art in view of the combination of Suzuki and

4   Schuba.

5

6   _____

7   In the paragraph spanning pages 9 and 10 of the First Amendment, Appellants presented

8   arguments regarding the claimed "selected ones of said mobile server wallets." In this regard,

9   Appellants note that another teaching (besides the teaching identified in the First Amendment)

10   has been found with regard to multiple wallets. However, Appellants maintain that neither of the

11   identified passages within detail how the multiple wallet servers are integrated into the system or

12   specifically how payment messages are to be routed to selected ones of the mobile server wallets.

13

14   In responding to these arguments, the Examiner asserted the following on page 10 of the

15   Second Office Action:

16   The Examiner respectfully disagrees. Applicants decision or choice in design of how the
17   multiple wallet servers are integrated into the system or specifically how payment messages are to
18   be routed to selected ones of the mobile server wallets merely signifies a choice in design [See In
19   re Fout, 213 USPQ 532 (CCPA 1982), In re Siebentritt, 152 USPQ 618 (CCPA 1967); In re Seid,
20   161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947); In re Wolfe, 116 USPQ 443, 444 (CCPA
21   1961))]. The disclosure of Suzuki teaches multiple wallet servers which can be integrated into a
22   system/method in order to route payment transactions.
23
24   Appellants are entirely unclear as to the relevance of these cases to the issues at hand.

25   Specifically, the Examiner is rejecting the claims for anticipation yet the Examiner has failed to

26   specifically identify the claimed limitations. For example, claim 1 recites that payment messages

27   are routed to selected ones of mobile server wallets, yet the Examiner fails to identify a teaching

1   within Suzuki as to this limitation. The Examiner's case law citations do not cure these

2   deficiencies.

3

4   ————————————————————————————————

5   <u>Claim 2</u>

6   In the first full paragraph on page 10 of the First Amendment, Appellants presented the

7   following arguments. Dependent claim 2 recites, in part, "a plurality of profiles

8   communicatively linked to said filter plug-in," and to teach this limitation the Examiner cited

9   paragraph [0030]. However, this passage (previously reproduced above) is silent as to a filter

10   plug-in and as to profiles that "[specify] a merchant configured to engage in mobile commerce

11   transactions through said wireless service provider network," as claimed. In this regard,

12   Appellants note that the Examiner's analysis fails to establish why the Examiner believes

13   paragraph [0030] identically discloses this limitation. Thus, the Examiner has failed to establish

14   that Suzuki identically discloses the claimed invention, as recited in claim 2, within the meaning

15   of 35 U.S.C. § 102.

16

17   The Examiner's did not directly respond to this argument in the Second Office Action.

18   Instead, the Examiner included claim 2 within "Argument B" and responded to Argument B on

19   page 10 of the Second Office Action. However, this response is entirely silent as to the

20   limitations recited in claim 2. Therefore, Appellants maintain that the Examiner to establish that

21   Suzuki identically discloses all of the limitations recited in claim 2.

22

1   <u>Claims 3-4, 6-8, and 10-12</u>[6]

2   With regard to claims 3-4, 6-8, and 10-12, the Examiner engages in a considerable

3   regarding "Official Notice" and as to how Appellants' traversal of the Examiner's Official Notice

4   was inadequate. Interestingly, however, the Examiner never took Official Notice of any of the

5   limitations recited in claims 3-4, 6-8, and 10-12. Moreover, Appellants did not traverse the

6   Examiner's Official Notice since the Official Notice was not made.

7

8   On page 13 of the Second Office Action, the Examiner asserted that "**Claims 3-4, 6-8,**

9   **and 9-12** are taken to be admitted prior art because Applicant's traversal was inadequate"

10   (emphasis in original). Appellants disagree. The fact that Appellants did not traverse the

11   Examiner's initial rejection is not dispositive as to whether Appellants agree or disagree that the

12   limitations added by claims 3-4, 6-8, and 10-12 are identically disclosed by Suzuki. Appellants

13   determined that the Examiner's rejection as to independent claims 1, 5, and 9 to be so deficient

14   that an analysis of the Examiner's rejection as to the dependent claims was unnecessary.

15

16   The Examiner's assertion on page 13 that "Applicant's challenge is not timely" would be

17   incorrect even if Appellants did traverse the Examiner's non-existent taking of Official Notice. If

18   Appellants did challenge, the challenge would have occurred during the First Amendment, which

19   would have been the first time Appellants had the opportunity to make such a challenge.

20

21   In most instances, Appellants would have treated the Examiner's comments on pages 12

22   and 13 as an artifact from a prior Office Action used as a template for the present Office Action,

---

[6] Although the Examiner refers to "9-12," Appellants proceed on the basis that the Examiner intended to refer to 10-12 since claim 9 had already been addressed.

1 which the Examiner inadvertently failed to delete. However, for the Examiner to update these

2 comments with the claims not addressed by Appellants and the dates of the First Office Action

3 and the First Amendment reflects the Examiner's intent that these comments apply to the present

4 application. Given the complete inappropriateness of the Examiner's assertions as to the present

5 application and given the other irregularities (e.g., the Examiner's unstated 103 rejection based

6 upon Schuba) within the Examiner's analysis, Appellants respectfully submit that substantial

7 flaws are present throughout the Examiner's rejection.

8

9   <u>Conclusion</u>

10   Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection

11 under 35 U.S.C. § 102 based upon the applied prior art is not viable. Appellants, therefore,

12 respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: April 8, 2008   Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A mobile commerce system comprising:

a plurality of mobile server wallets each wallet having an association with a corresponding subscriber in a wireless service provider network;

a proxy server disposed in said wireless service provider network; and,

a filter plug-in coupled to said proxy server and configured to intercept selected payment messages flowing through the proxy server and to route said payment messages to selected ones of said mobile server wallets.

2. The mobile commerce system of claim 1, further comprising a plurality of profiles communicatively linked to said filter plug-in, each of said profiles specifying a merchant configured to engage in mobile commerce transactions through said wireless service provider network, said filter plug-in having a further configuration for routing said payment messages to said selected ones of said mobile server wallets when a source of said payment messages matches a merchant identity specified in at least one of said profiles.

3. The mobile commerce system of claim 1, wherein individual ones of said mobile server wallets are disposed in at least one of an Internet service provider server, said wireless service provider network server, a merchant server, a financial institution server and a portal server.

4. The mobile commerce system of claim 2, wherein at least one of said profiles further comprises a specification of a markup language able to be processed in said filter plug-in.

5. A method for processing mobile commerce transactions in a wireless service provider network, the method comprising the steps of:

filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network; and,

routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers.

6. The method of claim 5, further comprising the steps of:

consulting filters which specify specific ones of said merchants;

monitoring message traffic flowing from said merchants; and,

intervening in purchase transactions originating in said merchants.

7. The method of claim 5, wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless service provider network.

8. The method of claim 5, wherein said routing step comprising routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers and selected by said specific subscribers.

9. A machine readable storage having stored thereon a computer program for processing mobile commerce transactions in a wireless service provider network, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network; and,

routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers.

10. The machine readable storage of claim 9, further comprising the steps of:

consulting filters which specify specific ones of said merchants;

monitoring message traffic flowing from said merchants; and,

intervening in purchase transactions originating in said merchants.

11. The machine readable storage of claim 9, wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless service provider network.

12. The machine readable storage of claim 9, wherein said routing step comprising routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers and selected by said specific subscribers.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.